

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re App. No.:	09/449,021	)	<u>PATENT APPLICATION</u>
		)	
Filing Date:	November 24, 1999	)	Art Unit: 2192
		)	
Inventors:	Helmut Emmelmann	)	Examiner: Kendall, Chuck
		)	
Title:	<i>Interactive Server Side Components</i>	)	

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Customer No.: 28554

**PETITION FOR RECONSIDERATION  
OF WITHDRAWAL OF NOTICE OF ALLOWANCE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

On July 9, 2008, the USPTO issued a notice indicating that the subject application was being withdrawn from issue and that the application was being forwarded to the examiner for action. Applicant respectfully requests reconsideration of that decision, including forwarding the application to the examiner for an ordinary action without any appeal status or other special priority.

**FACTS**

This application was originally filed in November 1999, with priority claims to two provisional applications filed in November 1998. During a first portion of prosecution, the examiner cited various prior art references, which were overcome by applicant.

After receiving a final rejection in June 2005, applicant filed arguments traversing the claim rejections in August 2005, then filed a first notice of appeal in September 2005.

An Advisory Action was issued in November 2005, stating that *“filt would however be distinct, if Applicant claimed dynamically editing a web page while the webpage is being run by the browser.”* (See Advisory Action at Continuation Sheet). Applicant thereafter argued that the suggested limitation was already contained in the language of other claims.

Applicant perfected its appeal by filing an appeal brief on February 13, 2006.

The Examiner reopened prosecution in June 2006 by issuing a new non-final office action in which all independent claims were rejected. In September 2006, applicant renewed its Notice of Appeal, and also filed a Request for Pre-Appeal Review.

In May and June of 2007, the Examiner spoke with Applicant's counsel on two occasions, and indicated that amendments were necessary to put the claims in statutory form, but also, that inclusion of a limitation to the feature of “dynamically editing” would place the claims in condition for allowance.

On July 2, 2007, the PTO finally mailed its decision on the request for pre-appeal review (10 months after the request was filed), but the decision did not include any substantive reasoning, noting only that prosecution is reopened and the current rejection withdrawn, and that a new office action would be mailed. A new office action was not mailed until the Notice of Allowance dated April 15, 2008.

On July 20, 2007, applicant submitted proposed amendments for the independent claims only, that were believed to satisfy the request made by the Examiner during the telephone interviews in May and June. However, the Examiner did not provide any comments or feedback on the proposed amendments. Applicant thereafter assumed that the proposed amendments would be acceptable, and submitted a proposed amendment including all claims in November 2007.

In April 2008, applicant received the Notice of Allowance.

In June 2008, however, the Examiner contacted applicant's counsel to inform him that Quality Review had concerns with the patentability of certain claims based on prior art to a software application called WebWriter. The Examiner faxed copies to applicant of two articles describing the WebWriter application, which we call “WebWriter I” and

“WebWriter II.” (Applicant notes that the WebWriter I reference was cited to the PTO by the applicant in the initial IDS in March 2000, well before the initial examination of this case.) Although applicant provided input to the Examiner regarding the differences between the claimed invention and the WebWriter references, the application was nevertheless withdrawn from issue on July 9, 2008.

#### ARGUMENT

It is noted that this application has been pending almost 9 years (10 years since the provisional application), and therefore it is considered “special” under PTO rules and should be advanced out of turn for examination. Applicant stands ready, willing and able to work with the Examiner toward obtaining allowance, and asks that efforts be expedited toward that objective. Applicant believes that most if not all of its claims contain patentable subject matter.

Applicant has the right to be heard by the Board of Appeals. The continued reopening of prosecution now 3 years after applicant first filed a notice of appeal, although laudable if a genuine attempt to advance prosecution is made, has deprived applicant of that right and delayed a decision on the merits. Although applicant is entitled to file a new notice of appeal once he receives a new office action, this would significantly delay the appeal process, and would also significantly impact the patent term. Patent term adjustments are very likely to be inadequate to compensate for the ongoing prosecution delays and diminished value of applicant's non-patented product.

Since the withdrawn allowance was actually the result of a series of events beginning with applicant's notice of appeal, applicant requests the opportunity to maintain or reinstate the priority date of its original appeal. Upon receiving the next office action, applicant then has the option to amend the claims accordingly, or cancel claims, or pursue the appeal under the original priority date based on the currently pending or amended claims.

Applicant understands that there is a random Quality Review (“QR”) process that is intended to identify and correct problems in the examination process. The fact that QR has acted on this application and caused it to be withdrawn from issue certainly indicates that there were problems, either during examination or during QR. Applicant should

have long ago had the opportunity to discuss and distinguish the WebWriter prior art, which has apparently been relied upon during the QR process, particularly since this art was contained in the first IDS submitted by applicant in the case, and more importantly, since it was considered by the examiner in the initial examination. Applicant therefore asks that this application be given priority and expedited action in order to minimize the delays caused.

Further, the fact that the WebWriter references fail to disclose the feature of running during editing as discussed above means that these references do not teach or suggest the claimed invention. This feature of “running during editing” is precisely the point of distinction described in the November 2005 Advisory Action, and thereafter discussed by the Examiner and applicant’s counsel.

Applicant’s editor beneficially shows server-based web applications during editing in a WYSIWYG mode, wherein the applications, except for editing features, look and function similar during editing and at run time. In order to accomplish this, the edited application is run during editing.

In contrast, the editor described in the WebWriter references does not run the edited application on the server during editing. For example, the WebWriter I application “adds a placeholder for the output area at the current insertion point. The output area object will be replaced at runtime by the output of a script . . . .” (See WebWriter I at page 4, column 2, 2<sup>nd</sup> paragraph)(emphasis added). Further, WebWriter II performs editing steps completely on the client, which teaches away from running the application during editing on the server. (See WebWriter II at page 1513, 2<sup>nd</sup> column, last paragraph: “The user can modify those properties and then click the Done button. This triggers a client side update of the document tree.”)(emphasis added).

Therefore, running the edited application during editing is a distinctive feature of applicant’s claims.

Another distinctive feature is displaying pages in a way that causes the pages to look similar during run time and editing, except for the presence of editing features. WebWriter does not teach or suggest this feature, as the placeholders displayed by WebWriter for dynamic areas clearly look different than the output of the script shown at run time.

Therefore, applicant requests that a new Notice of Allowance be promptly issued for all allowable claims, or alternatively, that rejected claims be identified for applicant so that applicant can decide whether to amend or cancel these claims. If the identification of rejected claims requires issuance of a new office action, then applicant requests that such action be expedited so that applicant can respond quickly. Further, applicant requests that the logic and reasoning applied by the QR process be promptly disclosed to applicant, either in writing or through an interview, so that applicant may move forward with amendments and/or arguments to obtain allowance.

Respectfully submitted,

Date: September 9, 2008

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